



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,075	11/06/2001	Johann Engelhardt	5005-1009	4876

23280 7590 12/02/2002

DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 SEVENTH AVENUE, 14TH FLOOR  
NEW YORK, NY 10018

EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
----------	--------------

2872

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/992,075

Applicant(s)

ENGELHARDT ET AL.

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmuth et al., U.S. Patent No. 5,795,295 in view of Kempe, U.S. Patent No. 6,151,127.

Hellmuth et al. discloses in fig. 1 an arrangement for visual and quantitative three-dimensional examination of specimens comprising a stereomicroscope (100, column 4, lines 65-67) with an objective (110) and a first and second eyepiece (180) wherein the objective and eyepieces define a first and a second beam path (fig. 1) and a scanning device (420) connected to the stereomicroscope thereby providing a scanning beam path (430) wherein the scanning device scans a specimen (1000) through the objective and acquires data for a three dimensional visual depiction of the specimen, wherein the stereomicroscope is equipped with a camera port (in so far as an imaging device is attached) at which the scanning device couples the scanning beam into the stereomicroscope, and wherein the scanning device is connected to a computer (500) that analyses the image data acquired and displays them on a display (210). Hellmuth et al. discloses

Art Unit: 2872

the claimed invention except for the scanning device being a confocal scanning device and a further lens being provided before the objective to guide the scanning beam path parallel to observation beam paths. Relay lenses are well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a relay lens between the mirror (120) and the objective to allow for longer focal distances within the stereomicroscope. Kempe teaches a confocal scanning device for examining biological tissue (fig. 1) with a computer (44) and display (46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the scanning device of Hellmuth et al. with the confocal scanning device of Kempe to provide better image resolution and contrast discrimination.

4. Claims 2, 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmuth et al. in view of Kempe, as applied to claims 1 and 8 above, and further in view of Kitagawa et al., U.S. Patent No. 6,297,904 B1.

Hellmuth et al. in view of Kempe, as applied to claims 1 and 8 above, discloses the claimed invention except wherein the confocal scanning device is mounted on the stereomicroscope so that the scanning beam is coupled into the path of at least one of the observation beam paths with an optical coupling-in element. Kitagawa et al. teaches a confocal microscope (fig. 3) wherein the confocal scanning device (20) is mounted on the stereomicroscope so that the scanning beam is coupled into the observation beam path (column 6, lines 4-19) with an optical coupling-in element (30). It would have been obvious to one of ordinary skill in the art at the time the invention was made use the optical coupling-in element of

Art Unit: 2872

Kitagawa et al. with the system of Hellmuth et al. in view of Kempe to macroscopically observe the confocal images of the specimen (Kitagawa et al., column 6, lines 17-19).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF  
November 26, 2002

  
**MARK A. ROBINSON**  
**PRIMARY EXAMINER**